

(U.S. Patent No. 4,939,666, issued July 3, 1990), in the Office Action mailed on September 27,

The rejection of claims 23-28 under 35 U.S.C. 102(b) as being anticipated by Hardman

Claim Rejections - 35 USC § 102

2, 2002, canceling claims 1-29, and establishing the proper antecedent basis for claims 30-35.

mailed on September 27, 2002, is withdrawn in view of the Amendment received on December

for failing to particularly point out and distinctly claim the subject matter, in the Office Action

The rejection of claims 2-3 under 35 U.S.C. 112, second paragraph, as being indefinite

withdrawn in view of the Amendment received on December 2, 2002, canceling the claims.

Possession of the claimed invention, in the Office Action mailed on September 27, 2002 is

skilled in the relevant art that the inventor(s), at the time the application was filed, had

matter which was not described in the specification in such a way as to reasonably convey to one

The rejection of claims 19-23 under 35 U.S.C. 112, first paragraph, as containing subject

Claim Rejections - 35 USC § 112

December 2, 2002, canceling the claims.

Action mailed on September 27, 2002 is withdrawn in view of the Amendment received on

The objection of claims 4-22 for being dependent on a canceled claim, in the Office

Claim Objections

Rejections Withdrawn

.8).

This Office Action responds the Amendment received on December 2, 2002 (Paper No.

DETAILED ACTION

Art Unit: 1637

cancelling the claims.

September 27, 2002 is withdrawn in view of the Amendment received on December 2, 2002, invention as that of claims 2-15 of prior U.S. Patent No. 6,188,955, in the Office Action mailed on The rejection of claims 6-10 and 12-17 under 35 U.S.C. 101 as claiming the same

Claim Rejections - 35 USC § 101 - Double Patenting

received on December 2, 2002, cancelling the claims.
Patent No. 6,269,312, mailed on September 27, 2002 is withdrawn in view of the Amendment obvioussness-type double patenting as being unpatentable over claims 2, 6, 11, and 18-21 of U.S. The rejection of claims 2, 6, 11, and 19-22 under the judicially created doctrine of

on December 2, 2002, cancelling the claims.

Office Action mailed on September 27, 2002, is withdrawn in view of the Amendment received same invention as that of claims 2-27 and 38 of copending Application No. 09/837,886, in the The provisional rejection of claims 2-17 and 19-29 under 35 U.S.C. 101 as claiming the

Double Patenting

written in view of the Amendment received on December 2, 2002, cancelling the claims.
5,241,470, issued August 31, 1993), in the Office Action mailed on September 27, 2002 is Hardman (U.S. Patent No. 4,939,666, issued July 3, 1990) in view of Lee et al. (U.S. Patent No. The rejection of claims 24-29 under 35 U.S.C. 103(a) as being unpatentable over

Claim Rejections - 35 USC § 103

2002 is withdrawn in view of the Amendment received on December 2, 2002, cancelling the

Art Unit: 1637

Application/Control Number: 09/827,960 Page 3

The following is a quotation of the first paragraph of 35 U.S.C. 112:

acid side chains. The base claim, however, lacks the concept of first and second sets of rotamers. Each residue position (which is variable), there exists rotamers of at least two different amino rotamers,” which lacks proper antecedent basis. The base claim 43 appears to indicate that for claims 44 and 45 are indefinite for reciting the term, “said first and second sets of regards as the invention.

for failing to particularly point out and distinctly claim the subject matter which applicant for claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Claim Rejections - 35 USC § 112 - Necessitated by Amendment

§ 608.01(u). Accordingly, the claim 48 has not been further treated on the merits.

multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP

claim 48 is objected to under 37 CFR 1.75(c) as being in improper form because a

claims 31-35 are objected to because they depend on a preceding claim.

Claim Objections - Necessitated by Amendment

is withdrawn in view of the Amendment received on December 2, 2002.

claim 2 of prior U.S. Patent no. 6,269,312), in the Office Action mailed on September 27, 2002

The rejection of claim 18 under 35 U.S.C. 101 as claiming the same invention as that of

Art Unit: 1637

introduce explicit backbone flexibility" (pp. 10, lines 22-28).

sytematically or randomly varied to alter the arrangement of the secondary structure elements to supersecondary structure parameters. These parameters are assigned values that can be relative positions of the secondary structural elements are defined by a set of parameters called is reduced to a description of the spatial arrangement of its secondary structural elements. The outlined below. In this embodiment, the representation of the starting protein backbone structure "In a preferred embodiment, the protein backbone structure is altered prior to the analysis

superssecondary structure. The specification discloses:

at least one structure parameter which is open to other structural parameters not pertaining to altering at least one superssecondary structure parameter (page 10), but not the concept of altering discloses "alters at least one structure parameter." The specification supports the concept of step which is not supported by the original disclosure. Specifically, sub-step (a) of claims 37-39 supported by the original disclosure is as follows: Newly added claims 37-39 recites a method introduce new matter into the disclosure of the invention. The added material which is not introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall possess the claimed invention. This is a new matter rejection.

The amendment filed on December 2, 2002 is objected to under 35 U.S.C. 132 because it skilled in the relevant art that the inventor(s), at the time the application was filed, had matter which was not described in the specification in such a way as to reasonably convey to one Claims 37-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject contemplated by the inventor of carrying out his invention.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode

2/5/03

Young J. Kim

such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. The Fax number is (703) 746-3172. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Art Unit: 1637

Page 7

Application/Control Number: 09/827,960

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s).
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6) Other:

Attachment(s)

- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 120 and/or 121.
 a) The translation of the foreign language provision application has been received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 * See the attached detailed Office action for a list of the certified copies not received.
 b) Application from the International Bureau (PCT Rule 17.2(a)).
 3. Copies of the certified copies of the priority documents have been received in this National Stage
 2. Certified copies of the priority documents have been received in Application No. _____
 1. Certified copies of the priority documents have been received.
 a) All b) Some * c) None of:
- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
Priority under 35 U.S.C. §§ 119 and 120
 12) The oath or declaration is objected to by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 9) The specification is objected to by the Examiner.

Application Papers

- 8) Claim(s) _____ are subject to restriction and/or election requirement.
 7) Claim(s) 31-35 and 48 is/are objected to.
 6) Claim(s) 37-39, 44 and 45 is/are rejected.
 5) Claim(s) 30, 36, 40-43, 46 and 47 is/are allowed.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 4) Claim(s) 30-48 is/are pending in the application.

Disposition of Claims

- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
 2a) This action is FINAL. 2b) This action is non-final.

- 1) Responsive to communication(s) filed on 02 December 2002.

Status

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any claimed patent term adjustment. See 37 CFR 1.70(d).
 - Failure to reply within the set or extended period for reply will by statute cause the application to become ABANDONED (35 U.S.C. § 133).
 - If the period for reply is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - After Six (6) MONTHS from the mailing date of this communication.
 - Extensions of time may be available under the provisions of 37 CFR 1.36(a). In no event, however, may a reply be timely filed if the period for reply specified above is less than thirty (30) days.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Period for Reply

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Applicant(s)	Application No.	Examiner	Office Action Summary
MAYO ET AL.	09/827,960	Young J. Kim	1637

1103942

Fax number: (415) 398-3249
 Telephone: (415) 781-1989

Four Embarcadero Center, Suite 3400
 San Francisco, CA 94111-4187

Intellectual Property Department

Dreyer & Whitley LLP

Custodian Number: 32940

Date: 4/20/03

By:

Robin M. Silve, Reg. No. 38,304
 Filed under 37 CFR, § 1.3(a)

DORSY & WHITNEY LLP
 Respectfully submitted,

Name: M. Treada, Reg. No. 47,244

Please appoint: Joyce L. Morrison, Reg. No. 31,902, and

copyied party application.

Applicant hereby requests it's undersigned counsel, that the individuals named below be appointed Associate Powers of Attorney and are authorized to prosecute matters in the above-

Sir

Commissioner for Patents
 Washington, D.C. 20231

ASSOCIATE POWER OF ATTORNEY

Signature

For: Applications and Method for
 Automated Protection Design

Filed: April 4, 2001

Serial No. 09/827,960

MAYO, et al.

In re application of

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent
 Attorney Docket No. 468268-00013/A-65353-TRTRMS/RMK

Please find below and/or attached an Office communication concerning this application or proceeding.

APPLICATION NO.	FILED DATE	FIRST NAME/INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 827,960	04-04-2001	Stephen L. Mayo	A-6333-7 RFT RMS RMK	7447
ROBIN M. SILVA, ESO, DORSY & WHITNEY LLP KIM, YOUNG J EXAMINER				
7590 02-10-2003				
San Francisco, CA 94111-4187 Four Embarcadero Center Suite 3400				
ART GNTT PAPER NUMBER 1637				
DATE MAILED: 02-10-2003				

UNITED STATES PATENT AND TRADEMARK OFFICE
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: 700 L'Enfant Promenade, SW, Washington, DC 20412-3737
www.uspto.gov

UNITED STATES PATENT AND TRADEMARK OFFICE

